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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,210	08/08/2003	Ronald D. Blum	63049.000070	4088

7590 02/27/2004  
J. Michael Martinez de Andino  
HUNTON & WILLIAMS  
Riverfront Plaza, East Tower  
951 East Byrd Street  
Richmond, VA 23219-4074

EXAMINER
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SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*mn*

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/637,210	BLUM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jordan M. Schwartz	2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1,2,5,10-13,15-18,24 and 25 is/are rejected.

7) ☒ Claim(s) 3,4,6-9,14 and 19-23 is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 10, that part of the claim stating, "gas permeable, non-gas permeable" renders the claim vague and indefinite. Specifically, any material will inherently have to be either gas-permeable or non-gas permeable and therefore it is not clear as to what this is adding as a limitation or how this is further limiting claim 1, rendering the claim vague and indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Large patent number 5,712,721.

Large reads on this claim by disclosing the limitations therein including the following: a method for making an electro-active contact lens system (column 1, lines 6-12, column 2, lines 52-64); comprising encapsulating an electro-active element (column 2, line 59); attaching the encapsulated electro-active element and a power source to provide power to the electro-active element (column 1,

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line 64, column 2, line 61); to a contact lens (column 1, lines 6-12); and the electro-active element encapsulated within a rigid material (column 2, line 59 re “protective outer layer” so therefore it will inherently be “rigid material”).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 10-13, 15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Large in view of Piosenka et al patent number 5,359,444.

Large discloses the limitations therein including the following: an electro-active contact lens system (column 1, lines 6-12, column 2, lines 52-64); an electro-active element attached to the contact lens (column 2, lines 52-64); a power source to provide power to the electro-active element (column 1, line 64, column 2, line 61); to a contact lens (column 1, lines 6-12). Large discloses as is set forth above and further discloses the ophthalmic optical device electrically switching between different focal states (abstract) but does not disclose a view detector (and specifically a rangefinder as per claim 2) attached to the contact lens in electronic communication with the electro-active element and attached to the power source. Piosenka et al teaches that in an ophthalmic lens system comprising an electro-active element attached to a power source for the purpose

of switching between different focal states (abstract), that it is desirable to further include a view detector, specifically a range finder, attached to the ophthalmic lens system in electronic communication with the electro-active element and attached to the power source for the purpose of providing auto-focusing (column 5, line 44 to column 6, line 25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the electro-active lens system of Large as further comprising a view detector attached to the contact lens in electronic communication with the electro-active element and attached to the power source since Piosenka et al teaches that in an ophthalmic lens system comprising an electro-active element attached to a power source for the purpose of switching between different focal states, that it is desirable to further include a view detector, specifically a rangefinder, attached to the ophthalmic lens system in electronic communication with the electro-active element and attached to the power source for the purpose of providing auto-focusing.

Large further discloses the power source as a conformal battery (column 1, line 64, column 5, line 40 to column 6, line 59). The contact lens of Large will inherently be either gas permeable or non-gas permeable and regardless, Large discloses the contact lens as gas permeable (column 6, line 65). Large further discloses the electro-active element contained within a capsule connected to the contact lens (Figures 1 and 2, column 2, line 59); the capsule constructed of a rigid material (column 2, line 59 re "protective outer layer" so therefore it will inherently be "rigid material"). The capsule will inherently provide a fixed distance

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optical power, this being reasonably based upon Large disclosing this material as a conventional ophthalmic lens material (column 6, line 65) which are known to provide a fixed focal length correction. Large further discloses the contact lens providing a fixed distance optical power (column 4, lines 31-40).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Large.

Large discloses as is set forth above but does not specifically disclose the contact lens material as comprising a hydrophilic material. However, Large teaches that the contact lens material is gas-permeable (column 6, line 65) and further that it is formed of "conventional ophthalmic lens material" (column 6, lines 65-67). The examiner takes Judicial Notice that it is well known in the art of contact lenses, particularly those that are gas permeable, for the lens material to include hydrophilic material for the purpose of providing improved comfort and gas permeability. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Large as comprising a hydrophilic material since Large teaches that the contact lens material is gas-permeable and further that it is formed of "conventional ophthalmic lens material" and since it is well known in the art of contact lenses, particularly those that are gas permeable, for the lens material to include hydrophilic material for the purpose of providing improved comfort and gas permeability.

***Allowable Subject Matter***

Claims 3-4, 6-9, 14, 19-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claim 3, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector comprising a tilt switch. Specifically, with reference to claim 4, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector comprising a micro-gyroscope. Specifically, with reference to claims 6-9 and 20-23, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector stabilized between a palpebral fissure of a patient's eye. Specifically, with reference to claims 14 and 19, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector contained in the capsule.



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***Prior Art Citations***

Schachar is being cited herein to show a lens system having some similar structure to that of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
February 17, 2004